

REMARKS

Reconsideration of the application is respectfully requested.

1. Examiner has rejected claims 1 – 8 as being unpatentable under 35 USC 103(a) over the Daines reference ('565) in view of the Webb reference ('719).

With respect, it is submitted that a *prima facie* case of obviousness is not made out by combining the Daines and Webb references.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (See MPEP 2143.03) *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The present invention provides a variant form of blackjack, where a conventional game of blackjack is played, and at the same time, a 3-card game combining elements of poker and blackjack is played. In particular, the three initial cards formed by the players first two cards and the dealers first card forms a hand, which determines the wager of the player playing a side bet.

The Daines reference does not disclose such a three card side bet.

The Webb reference does disclose a three card side bet, however, there is a significant difference between the present claimed invention and the Webb reference. In Webb, the winning hands in the three card side bet are all winning poker hands. The description consistently refers to the three card hands as "3-card Poker" hands. The winning tables in column 4 are all Poker hands. In the present invention, winning three card hands include numerical winning hands which are greater than or equal to 19, but not greater than 21. In other words, winning three card hands in the present invention are based on blackjack hands. While elements of poker are possible in the rules, a winning hand must greater than or equal to 19 without busting.

Webb does not teach counting the three card hand blackjack style in order to determine a winning hand. Webb is limited to 3-card Poker hands such as flushes, straights and three-of-a-kind.

Therefore, because the cited prior art does not teach all of the limitations of claim 1 or claim 7, a *prima facie* case of obviousness does not result.

2. Examiner has rejected claims 1-8 of the present application under the judicially created doctrine of double patenting over claims 1-6 of the Daines reference.

MPEP 8.32 defines double patenting as follows:

In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is - does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? If the answer is yes, then an "obviousness-type" nonstatutory double patenting rejection may be appropriate. Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is **not patentably distinct** from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1865 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000).

As stated above, the claims in the present application are not obvious in view of the Daines reference. They are not an "obvious variation" of the earlier claims. The claims in the Daines reference are limited to a blackjack variant game, where the "push" result of a tie between dealer and player is eliminated. In the present case, a three-card optional side bet is presented.

Therefore, the subject matter of the present application was not disclosed in the earlier Daines reference and double patenting does not exist.

CONCLUSION

In view of the foregoing remarks and amendments, it is respectfully submitted that this application is in condition for allowance and allowance thereof is respectfully requested.

Respectfully submitted,

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